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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/719,604

11/21/2003

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NAZA101

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12/12/2006

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EXAMINER

COHEN, LEE S

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/719,604

Applicant(s)

NAZERI, ALIREZA

Examiner

Lee S. Cohen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/10/06;11/13/06.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-55 is/are pending in the application.
4a) Of the above claim(s) 29-55 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1 and 3-28 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 10 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

It is noted that claim 3 depends upon cancelled claim 2. For purpose of examination, claim 3 will be considered to be dependent upon claim 1. Any response to this action should amend claim 3 to be properly dependent upon claim 1.

Election/Restrictions

Claims 29-55 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 6, 2006.

Double Patenting

Applicant is advised that should claim 5 be found allowable, claim 25 will be objected to under 37 CFR 1.75 as being a duplicate thereof. When two claims in an application are duplicates, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 11, 16, 18-22, 26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dominguez (6,560,473) in view of Sujdak (6,847,836). Dominguez discloses the basic pad structure (Figure 2) including a plurality of electrodes and a positioning device 52. The reference broadly details the pad at column 4, line 58+ but fails to disclose particular

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structural features of the pad including the adhesive surface, electrodes, and wires. Such features are disclosed by Sujdak in Figures 2-4 (see column 4, line 15 – column 5, line 14. Figure 4 of Sujdak clearly illustrates the electrode 62 extending slightly from the pad body. Given this teaching, it would have been obvious to the skilled artisan to modify Dominguez with such features since they are mere expedients in design that are well known and would optimize the structure of the pad.

Claims 3, 5, 6, 8-10, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dominguez (6,560,473) in view of Sujdak (6,847,836) as applied to claim 1 above, and further in view of Rogel (6,259,939). Dominguez discloses wire cables for the electrodes connected to a connection point but fails to include a data module or a wireless transmitter. Such features are disclosed by Rogel at column 6, line 57+. Given this teaching, it would have been obvious to the skilled artisan to modify Dominguez with a module having a wireless transmitter and/or wires to permit remote monitoring of the patient.

Claims 4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dominguez (6,560,473) in view of Sujdak (6,847,836) as applied to claim 1 above, and further in view of Haines et al (6,385,473). Dominguez fails to include a temperature sensor. Haines et al disclose a similar EKG sensor arrangement including a temperature sensor at column 6, line 63+. Given this teaching, it would have been obvious to the skilled artisan to modify Dominguez with a temperature sensor to permit more detailed monitoring of the vital signs of the patient.

Claims 7 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dominguez (6,560,473) in view of Sujdak (6,847,836) as applied to claim 1 above, and further in view of Mok et al (6,643,541). Dominguez fails to include a micro-transmitter for each electrode.

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Mok et al disclose the use of individual transmitters for each electrode (e.g., see Figure 1). Given this teaching, it would have been obvious to the skilled artisan to modify Dominguez with individual transmitters for the electrodes to eliminate wiring in the pad.

Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dominguez (6,560,473) in view of Sujdak (6,847,836) as applied to claim 1 above, and further in view of Sekine (5,224,479). Dominguez and Sujdak fail to include an extension device for the electrode. Sekine discloses such a device for electrodes in Figure 3. Given this teaching, it would have been obvious to the skilled artisan to modify the electrodes by adding an extension device to ensure adequate skin contact.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dominguez (6,560,473) in view of Sujdak (6,847,836) and Sekine (5,224,479) as applied to claim 12 above, and further in view of Rollman et al (5,370,116). The combination fails to show a foam extension device for the electrode. Rollman et al disclose such a feature for electrodes in Figure 3b. Given this teaching, it would have been obvious to the skilled artisan to modify the extension device of the electrodes by using foam to ensure adequate skin contact.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dominguez (6,560,473) in view of Sujdak (6,847,836) and Rogel (6,259,939) as applied to claim 3 above, and further in view of Sekine (5,224,479) and Haines et al (6,385,473). The combination fails to show a temperature display. As detailed supra, Haines et al disclose temperature monitoring. Sekine further discloses a display module on an EKG pad. Given these teachings, it would have been obvious to the skilled artisan to modify the device by adding a display module with a

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temperature display to permit a physician to obtain instantaneous feedback of the patient's parameters.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dominguez (6,560,473) in view of Sujdak (6,847,836) as applied to claim 1 above, and further in view of Sekine (5,224,479) and Haines et al (6,385,473). The combination fails to show a temperature display. As detailed supra, Haines et al disclose temperature monitoring. Sekine further discloses a display module on an EKG pad. Given these teachings, it would have been obvious to the skilled artisan to modify the device by adding a display module with a temperature display to permit a physician to obtain instantaneous feedback of the patient's parameters.

Response to Arguments

Applicant's arguments filed October 10, 2006 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Further, "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what

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the combined teachings of those references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In addition, an obviousness rejection is warranted regarding claims that require no more change than designing one prior reference into another. See *In re Vamco, Machine & Tool, Inc.*, 224 USPQ 621 (March 4, 1985).

Accordingly, the combined teachings of the prior art clearly suggest the claimed pad structure particularly since the primary reference shows a positioning device for placing the pad on a patient.

Specification

The disclosure is objected to because of the following informalities: Paragraph [0054] should reference Figure 10 in lieu of Figure 11.

Appropriate correction is required.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee S. Cohen whose telephone number is 571-272-4763. The examiner can normally be reached on Monday-Friday, 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lee S. Cohen
Primary Examiner
Art Unit 3739

LSC
December 8, 2006